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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,540	10/25/2001	Bernard Gaudilliere	5882-66-BD	8823

7590

02/21/2003

Claude F Purchase Jr  
Warner Lambert Company  
2800 Plymouth Road  
Ann Arbor, MI 48105

EXAMINER
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KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,540

Applicant(s)

Gaudilliere et al.

Examiner

Bruck Kifle, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 25, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 & 5 6) ☐ Other:

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***Abstract***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper content of an Abstract of the Disclosure. In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

***Claim Rejections - 35 USC § 112***

Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) The phrase "Triazolo [4,3-a] quinazoline-5-ones and or -5-thiones of formula I or II : I and II are position isomers of group R on nitrogens 3 or 4, in which" in claim 1 is extraneous text. It is suggested to replace this with "A compound of formula I or II". The structural formula and definitions of the variables fully describe the compound claimed. The dependent claims could then be rewritten as, for example, "The compound according to claim 1".
- ii) Applicants are urged to go through the claims and correct spelling and grammatical errors.

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For example, page 152, first line, it is unclear what the "one group" is.

When denoting cyclic groups, language such as, "X<sub>3</sub> and X<sub>4</sub> along with the nitrogen they are attached to form a 5 or 6 membered saturated heterocyclic ring comprising 1-3 heteroatoms selected from the group consisting of O, S and N" is suggested which says that the ring is saturated, monocyclic, denotes the number of heteroatoms present and the size of the ring.

Instead of "possibly substituted" the phrase "optionally substituted" is proper.

Instead of "one or several groups chosen amongst halogen, hydroxy,,,,,, or -CO-Q<sub>1</sub>-Q<sub>2</sub>-Q<sub>3</sub>" the phrase "selected from the group consisting of halogen, hydroxy ,,,,,, and -CO-Q<sub>1</sub>-Q<sub>2</sub>-Q<sub>3</sub>" is proper Markush language.

The term "keto" should be replaced by "oxo".

"Alcoxy" should be replaced by "alkoxy" (see page 153, line 13).

The last line should also comply with proper Markush language, such as, "or a pharmaceutically acceptable salt thereof."

Thus, the terms "including" and "possibly" should be appropriately replaced in the claims.

iii) Claims 10-12 should be rewritten as independent claims because they cannot depend from claim 1. All of the variables should be defined in the claims as well. It is suggested to rewrite the claims as, for example, "A compound of formula III". The term "general" renders the claims indefinite.

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iv) In claims 13 and 14, the language "A process of producing a compound according to claim 1" is suggested to have the claims in proper dependent form.

v) Rewriting claim 17 as "A pharmaceutical composition comprising a compound according to any one of claims 1-9 and a pharmacologically acceptable carrier." is suggested.

vi) The variable  $A_1$  is not present in the formula in claim 10.

Claims 18-34 provide for the use of a compound, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 18-34 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Kappe et al. (Monatshefte fuer Chemie (1967), 98(1), 214-18). The claim reads on the compound of RN 13906-05-3P (see CAS abstract and structure).

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Misra et al. (Pesticide Science (1982), 13(2), 177-82). The claim reads on the compounds of RN 18730-39-7 and 35977-17-4 (see CAS abstract and structures).

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Omar et al. (Pharmazie (1979), 34(11), 747-8. The claim reads on the compound of RN 74395-78-1 (see CAS abstract and structure).

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Kottke et al. (DD 158549). The claim reads on the compounds on page 21 (see Table 6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.


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The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

February 13, 2003

  
**Bruck Kifle**  
**Primary Examiner**  
**Art Unit 1624**